

Claim Objections

Claims 20-23, 33-36, 66-68, 77, 78, 103-106, 124, and 125 stand objected to as being of improper dependent form for failing to further limit the subject matter of a previous claim, because the “objected to claims recite a method, and base their dependency on claims for a device, and therefore fail to further limit the device claims because they fail to present any structural elements.”

Applicant respectfully traverses the objections of these claims, since the fact that a claim that depends from an apparatus claim does not recite additional structural elements does not render it an improper dependent claim. “The test as to whether a claim is a proper dependent claim is that it shall include every limitation of the claim from which it depends (35 U.S.C. 112, fourth paragraph) or in other words that it shall not conceivably be infringed by anything which would not also infringe the basic claim.” See MPEP 608.01(n) (III).

In the instant case, method claims 20-23, 33-36, 66-68, 77, 78, 103-106, 124, and 125, by definition, require every limitation of the stimulation or medical kits of claims 1, 24, 48, 69, 85, and 107, and thus, the use of a stimulation or medical kit in the manner required by these method claims would clearly infringe the stimulation or medical kit claims from which these claims depend. It is noted that “the fact that the independent and dependent claims are in different statutory classes does not, in itself, render the latter improper.” See MPEP 608.01(n)(III). Therefore, the fact that claims 20-23, 33-36, 66-68, 77, 78, 103-106, 124, and 125 are method claims, and claims 1, 24, 48, 69, 85, and 107 are apparatus or kit claims is irrelevant to the determination of whether the method claims are in proper dependent format.

Thus, Applicant believes that claims 20-23, 33-36, 66-68, 77, 78, 103-106, 124, and 125 are in proper dependent format, and as such, respectfully requests withdrawal of the objections to these claims.

Claim Rejections-Obviousness (Cross)

Claims 1-7, 9, 10, 24-29, 31, 32, 48-54, 56, 57, 69-74, 76, 85-90, 92, 93, 102, 107-112, 114, and 115 stand rejected under 35 U.S.C. §103, as being obvious over U.S. Patent No. 6,587,733 issued to Cross, Jr., et al. ("Cross"). Applicant respectfully traverses this rejection, since Cross does not disclose, teach, or suggest the combination of elements required by these claims.

At the outset it should be noted that "obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art." See MPEP §2143.01 (I). The Examiner has not pointed to any teaching, suggestion, or motivation in the prior art to modify the Cross device in the manner suggested by the Examiner.

Instead, the Examiner essentially concludes that the claimed combination would have been obvious over Cross, because merely constructing the integrated Cross device into separate elements and that making the parts of the Cross device movable without a new or unexpected result involves only routine skill in the art. However, the fact that a claimed invention is within the capabilities of one of ordinary skill in the art is insufficient, by itself, to establish a prima facie case of obviousness. See MPEP §2143.01(IV). Thus,

notwithstanding that Applicant disagrees that the suggested modification to the Cross device would involve only routine skill in the art and that such a modification would not have a new or unexpected result, these findings, alone, are insufficient to establish that the claimed invention is obvious over Cross.

Notably, the Examiner cites Nervin v. Erlichman, 168 USPQ 177, 179 (1969) and In re Lindberg, 93 USPQ 23 (CCPA 1952) in supporting the conclusion that the modification of the Cross device would have been obvious because it involves only routine skill in the art. However, Nerwin simply holds that the “mere fact that a given structure is integral does not preclude its consisting of various elements.” It is noted that this statement was made in the context of determining whether an interference count could be supported—an inquiry completely irrelevant to the issue of obviousness. Lindberg simply holds that merely making a claimed device portable or movable is not sufficient by itself to patentably distinguish an otherwise old device unless there are new or unexpected results. The claimed device in question in Lindberg was a power spraying device that is portable or movable. The claimed device in the instant case; i.e., the stimulation kit, is not made any more movable or portable than the device disclosed in Cross, so Applicant fails to appreciate the relevance of Lindberg to the present case. In any event, as disclosed in the specification, the claimed invention provides the advantage of allowing the stimulation leads to be delivered percutaneously into the patient, while retaining the advantages of a surgical lead (see page 3, line 9 to page 4, line 7; and page 7, lines 3-10). While Cross discloses that its lead can be percutaneously introduced into a patient, a non-standard needle must be used (see col. 2, lines 34-38).

Thus, Applicant submits that claims 1-7, 9, 10, 24-29, 31, 32, 48-54, 56, 57, 69-74, 76, 85-90, 92, 93, 102, 107-112, 114, and 115 are not obvious over Cross, and as such, respectfully request withdrawal of the §103 rejection of these claims.

Claim Rejections-Obviousness (Cross and Morgan)

Claims 18, 20-23, 33-44, 46, 47, 65-68, 77-84, 101, 103-106, and 123-125 stand rejected under 35 U.S.C. §103, as being obvious over Cross in view of U.S. Patent No. 6,988,007 to Morgan, et al. ("Morgan"). Applicant respectfully traverses this rejection, no proper combination of Cross and Morgan discloses, teaches, or suggests the combination of elements required by these claims. In particular, as discussed above, the stimulation and medical kit claims from which these claims depend are not obvious over Cross, and Morgan does not supplement the failed teachings of Cross.

Thus, Applicant submits that claims 18, 20-23, 33-44, 46, 47, 65-68, 77-84, 101, 103-106, and 123-125 are not obvious over any proper combination of Cross and Morgan, and as such, respectfully request withdrawal of the §103 rejection of these claims.

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